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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,969	01/15/2002	Yousuke Moriuchi	026575-065	2991
7590	02/24/2005		EXAMINER	
Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/044,969	MORIUCHI ET AL. <i>CW</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bradford C Pantuck	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 August 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 and 6-16 is/are pending in the application.

4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4, 6, 7, and 16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input checked="" type="checkbox"/> Other: <u>Attachment A</u> .

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 6, 7, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Publication No. WO 99/36002 to Vardi et al. Regarding Claim 1, Figure 10 shows an expanding stent with waved connecting members (114) having waves with varying amplitudes and the other features claimed by the Applicant.
2. Regarding Claim 2, waved connecting member “X” connects two bottoms of waved elements and connecting member “Y” connects two ridges of waved elements [see Attachment A].
3. Regarding Claim 3, upon visual inspection of the proportions shown in Figure 10, the width of each waved connecting member (114) is less than half the thickness of the waved elements of the annular expanding members. Further, because the Patent and Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed subject matter is not anticipated or unobvious, the examiner properly shifts the burden to applicants to show *unanticipated* or unobvious differences exist, *Ex parte Phillips*, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93).
4. Regarding Claim 4, similarly, since the members Fig. 10 of the prior art seems to have similar proportions to Fig. 3 of Applicant’s invention, it can be assumed that

these *same components of Fig. 10* will have a similar range of thickness.

Furthermore, because the Patent and Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed subject matter is not anticipated or unobvious, the examiner properly shifts the burden to applicants to show *unanticipated* or unobvious differences exist, Ex parte Phillips, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93).

5. Regarding Claim 6, the length of the Vardi's waved connecting member (114) is at least 1.3 times as much as the straight distance between ridges of the waved elements of adjacent annular expanding members, as measured in Fig. 10 using a string.
6. Regarding Claim 7, Vardi's invention is intended for use in the same part of the body as Applicant's invention (arteries/veins) this strongly suggests that the two stents would be largely the same size and thus have the same size in addition to the same proportions. By comparing Fig. 10 of Vardi's invention to Fig. 3 of Applicant's the clearance width between adjacent annular expanding members appears to be of the same proportion. Although this does not prove with absolute certainty that this distance is necessarily between 0.4 mm and 0.8 mm it does prove that the proportions of Vardi are the same as the proportions of Applicant's invention. Finally, because the Patent and Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed subject matter is not anticipated or unobvious, the examiner properly shifts the burden to applicants to show

*unanticipated* or unobvious differences exist, Ex parte Phillips, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93).

7. Regarding Claim 16, Vardi discloses waved connecting members each having four waves. Each trough or peak is considered to be one wave.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Response to Arguments*

9. Applicant's arguments filed August 30, 2004 have been fully considered but they are not persuasive. WO 99/36002 to Vardi et al. discloses waved connecting members that meet the claimed subject matter that was added to claim 1, as illustrated in Attachment A (blown up view of Fig. 10 of WO 99/36002).

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10. Applicant's arguments, see "REMARKS", filed August 30, 2004, with respect to the rejection of claims 1, 2, and 4-7 with U.S. Patent No. 6,183,506 B1 to Penn et al. have been fully considered and are persuasive. However, upon further consideration, a new ground(s) of rejection of claims 2, 4, 6, and 7 has been made with WO 99/36002 to Vardi et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*BCP*  
BCP  
February 10, 2005

*VN*  
ANHTUAN T. NGUYEN  
PRIMARY EXAMINER

*2/16/05*

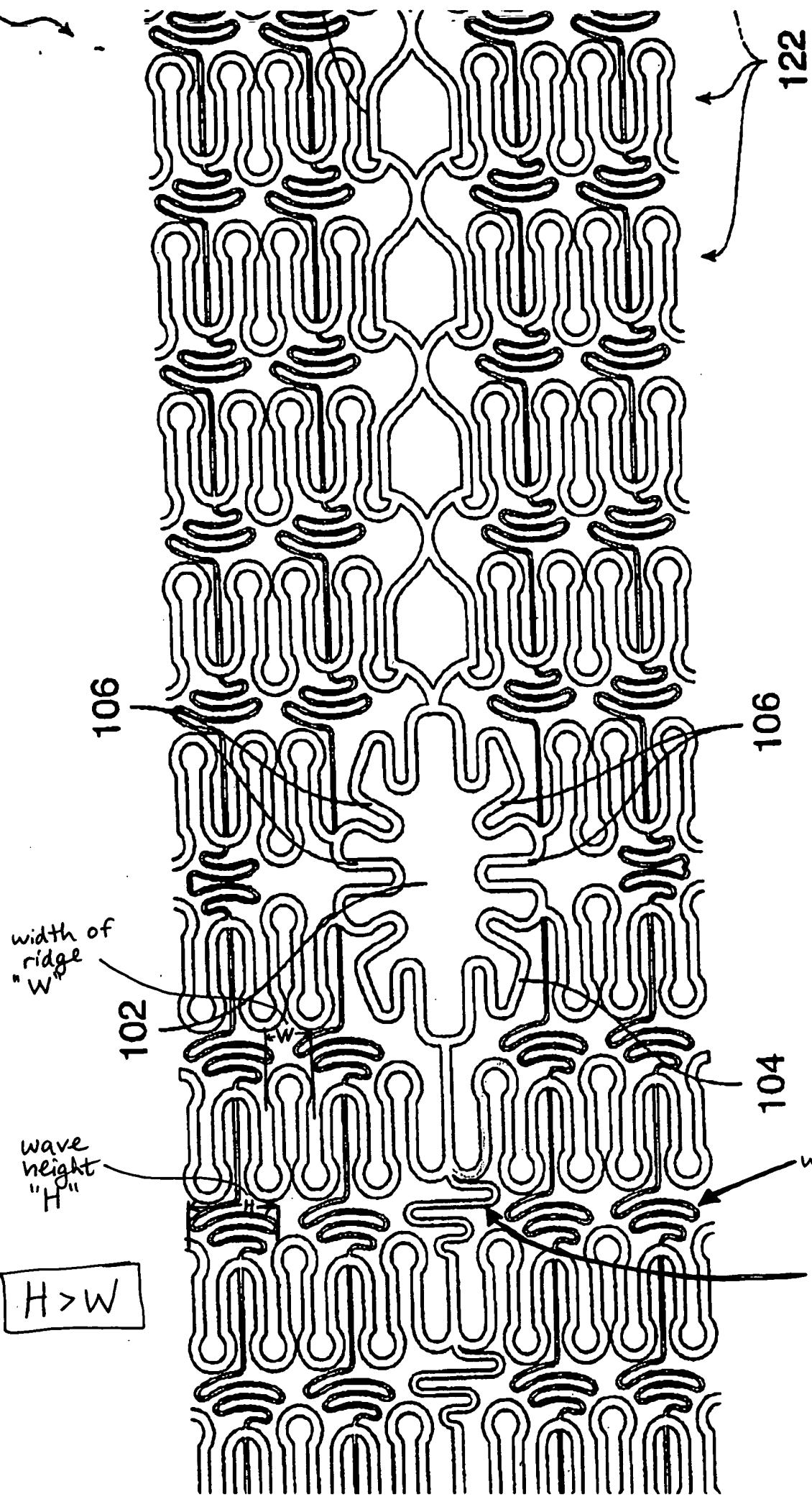


FIG. 10 (PCT/US99/00835)